

REMARKS***Status of Claims***

The Office Action mailed October 16, 2007, has been received and reviewed. By the present Response, claims 1, 10, 15, 23, and 25 are amended, claim 13 is withdrawn, and claims 2, 11-12, 14, 24, 26, and 27 are cancelled. Currently pending in the application, then, are claims 1, 3-10, 13, 15-23, and 25 of which claims 1, 15, and 25 are independent. No new matter is introduced by the present Response. All claims are now believed to be in condition for allowance for the reasons set forth below.

Rejection of Claims 25-26 under 35 U.S.C. §101

Claims 25-26 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicants respectfully traverse this rejection. Nevertheless, to advance prosecution, Applicants have cancelled claim 26 and amended claim 25 to clarify the claimed invention. Accordingly, Applicants submit that claim 25 is indeed directed to statutory subject matter and respectfully request that the Examiner withdraw this rejection.

Rejection of Claims 10 and 23 under 35 U.S.C. §112

Claims 10 and 23 stand rejected under U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner is unclear as to how a link of a sound to an emoticon can be encoded as a MIME attachment. Applicants respectfully traverse this rejection. Nevertheless, to advance prosecution, Applicants have amended independent claims 10 and 23.

Claim 10 is amended to depend from claim 8, and claim 23 is amended to depend from claim 21. Applicants have clarified that step of forwarding includes forwarding the sound file via a MIME-encoded attachment. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claims 10 and 23.

Rejection of Claims 1-6, 8-9, 15-18, 20-22, and 25 under 35 U.S.C. §102(e)

Claims 1-6, 8-9, 15-18, 20-22, and 25 stand rejected under 35 U.S.C. §102(e) as being anticipated by Isaacs et al. (US Patent Publication No. 2004/0215728). Applicants respectfully traverse this rejection.

The present invention is directed to linking an emoticon with a sound and forwarding the emoticon with its link to the sound to a recipient. An emoticon, as well known to those skilled in the art, typically consists of one or more keyboard characters which can be understood to convey voice express, facial expressions (such as a smiley face or a wink), gestures, etc. (see also paragraph 0002 on page 1 of the present application).

For example, independent claim 1 recites:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server for facilitating communications between the sender and the recipient, the method comprising the steps of:

- linking a sound file to an emoticon contained in a sender-generated message;

- forwarding the emoticon and its link to the sound file to the recipient;

- determining if the recipient already has the sound file, and if not sending the sound file to the recipient; and

- at the recipient, displaying the emoticon and audibly playing the sound file linked to the emoticon.

By stark contrast, the invention of Isaacs is directed to a system for transmitting earcons, not emoticons. The sender selects an icon (not an emoticon) and the system transmits a corresponding sound to the recipient. In other words, the invention of Isaacs transmits only sound, not any corresponding text or image. Thus, the invention of Isaacs fails to disclose at least the features of (1) linking (or logic configured to link) a sound file to an *emoticon*, (2) forwarding (or logic configured to forward) the emoticon *and* its link to the sound file to the recipient, and (3) at the recipient, displaying the emoticon and audibly playing the sound file linked to the emoticon, as claimed in independent claims 1, 15, and 25. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 15, and 25.

For at least the reasons that dependent claims 3-6, 8-9, 16-18, and 20-22 (as claim 2 is cancelled herein) include the limitations of independent claims 1 or 15, these dependent claims are allowable for at least the reasons set forth above for the corresponding independent claim. Thus, claims 3-6, 8-9, 16-18, and 20-22 are also allowable. Accordingly, allowance of claims 3-6, 8-9, 16-18, and 20-22 is respectfully requested.

Rejection of Claims 14, 24, 26, and 27 under 35 U.S.C. §102(e)

Claims 14, 24, 26, and 27 stand rejected under 35 U.S.C. §102(e) as being anticipated by Werndorfer et al. (US Patent Publication No. 2004/0024822). Applicants have cancelled claims 14, 24, 26, and 27, and thus this rejection is moot.

Rejection of Claims 1, 7, 15 and 19 under 35 U.S.C. §102(e)

Claims 1, 7, 15, and 19 stand rejected under 35 U.S.C. §102(e) as being anticipated by Ostermann et al. (US Patent No. 6963839). Applicants respectfully traverse this rejection. Nevertheless to advance prosecution, Applicants have amended independent claims 1 and 15.

The Ostermann patent is directed to a system and method for transmitting multi-media messages through a web server on the Internet. A user logs into the server and generates a multi-media message by inputting the text to be delivered, selecting an animated entity (e.g., a face) to deliver the message, and adding emotional elements to the animated entity (for yelling, whispering, etc.). The entire multi-media message is delivered to the recipient via a streaming video client (such as MICROSOFT MEDEIAPLAYER® or REAL PLAYER®). Accordingly, the system does not make a determination whether or not the recipient has the sound file, as claimed in independent claims 1 and 15. Rather, the system appears to automatically transmit the entire multi-media message with sound, which is contrary to the presently claimed invention. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1 and 15.

For at least the reasons that dependent claims 7 and 19 include the limitations of independent claims 1 or 15, these dependent claims are allowable for at least the

reasons set forth above for the corresponding independent claim. Thus, claims 7 and 19 are also allowable. Accordingly, allowance of claims 7 and 19 is respectfully requested.

Rejection of Claims 1, 10, 15 and 23 under 35 U.S.C. §102(b)

Claims 1, 10, 15 and 23 stand rejected under 35 U.S.C. §102(b) as being anticipated by Mages et al. (US Patent No. 6463467). Applicants respectfully traverse this rejection. Nevertheless to advance prosecution, Applicants have amended independent claims 1 and 15.

The Mages passage relied on by the Examiner (namely column 3) appears to describe conventional emails with MIME capabilities. As such, the emails are transmitted along with the contents, including any sound and images. Accordingly, the email system does not make a determination whether or not the recipient has the sound file, as claimed in independent claims 1 and 15. Rather, the email system automatically transmits the entire email message with any associated sound, which is contrary to the presently claimed invention. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1 and 15.

For at least the reasons that dependent claims 10 and 23 include the limitations of independent claims 1 or 15, these dependent claims are allowable for at least the reasons set forth above for the corresponding independent claim. Thus, claims 10 and 23 are also allowable. Accordingly, allowance of claims 10 and 23 is respectfully requested.

CONCLUSION

In view of the amendments submitted herein and the above comments, Applicants respectfully solicit allowance of the application. Should there be any further questions or concerns, the Examiner is urged to telephone the undersigned attorney to work through any remaining issues and bring this case to a mutually agreeable conclusion.

Respectfully submitted,
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